

REMARKS

This Amendment is submitted prior to continued examination of the present application and in response to the final action that issued on February 2, 2007. Claims 1-61 were pending in the application. In the official action, claims 35-46, 53-56, 59 and 61 were withdrawn from consideration, and claims 1-34, 47-52, 57, 58 and 60 were rejected. In this Amendment, claims 1, 7, 13, 24, 47, 50, 57, 58 and 60 have been amended. Claims 1-34, 47-52, 57, 58 and 60 thus remain for consideration.

Applicant submits that claims 1-34, 47-52, 57, 58 and 60 are in condition for allowance and requests withdrawal of the rejections in light of the following remarks.

\$112 Rejections

Claims 13-34, 47-52, 58, and 60 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant has amended claims 13, 24, 47, 50, 58, and 60 and submits that the amendments render claims 13-34, 47-52, 58, and 60 definite. Accordingly, Applicant requests withdrawal of the 112 rejections that are based on indefiniteness.

Claims 1-34, 47-52, 57, 58, and 60 were rejected under 35 U.S.C. §112, second paragraph, as being incomplete for omitting essential elements or steps. More specifically, the Examiner asserts that the claims omit the essential elements (or steps) of: (i) a transmitter (or transmitting step) for transmitting the digital watermark or information for reconstructing the digital watermark, and (ii) an acquiring unit (or acquiring step) for acquiring the digital watermark or information for reconstructing the digital watermark.

Applicant submits that the elements/steps cited by the Examiner are not "essential" to the claims. More particularly, Applicant points out that although such elements/steps are described in the section of the application entitled "Description of the Preferred Embodiments," they are not "essential" to practice of the invention as claimed. For example, claim 1 is directed to an apparatus for embedding information. Operation of an apparatus for embedding information does not require a transmitter or an acquiring unit for acquiring the information to be embedded. It merely requires that the information to be embedded is available at the apparatus (e.g., stored in a memory of the apparatus).

In view of the above, Applicant requests withdrawal of the 112 rejections that are based on omission of essential elements or steps.

\$102 and \$103 Rejections

Claims 1-3, 7-9, and 57 were rejected under 35 U.S.C. \$102(e) as being anticipated by Rhoads et al. (U.S. Patent No. 6,614,914).

Claims 1-5, 7-11, 13, 14, 16-25, 27-34, 47-52, 57, 58, and 60 were rejected under 35 U.S.C. \$103(a) as being unpatentable over Shur (U.S. Patent No. 6,330,672) in view of Rhoads.

Claims 6 and 12 were rejected under 35 U.S.C. \$103(a) as being unpatentable over Shur in view of Rhoads as applied to claims 1 and 7, and further in view of Girod et al. (U.S. Patent No. 5,809,139) and Kubota et al. (U.S. Patent No. 5,721,778).

Claims 15 and 26 were rejected under 35 U.S.C. \$103(a) as being unpatentable over Shur in view of Rhoads as applied to claims 13 and 24, and further in view of Girod.

Applicant submits that independent claims 1, 7, 13, 24, 47, 50, 57, 58 and 60 are patentable over Rhoads, Shur, Girod, and Kubota.

Each of claims 1, 7, 13, 24, 47, 50, 57, 58 and 60 recites that "[a] digital watermark is modulated according to an embedding modulation signal that is determined on the basis of one or more characteristics of the content" and that "the modulated digital watermark is embedded into [] content according to insertion information such that the digital watermark can be removed from the content by using the insertion information and the modulated digital watermark." Each of the claims further recites that "embedding of the modulated digital watermark includes encoding insertion code information based on the modulated digital watermark." (Emphasis supplied) Supporting disclosure for the Applicant's insertion information can be found in the specification at, for example, paragraphs [0084] - [0086].

Neither Rhoads, Shur, Girod, nor Kubota discloses embedding a modulated digital watermark into content according to insertion information that is generated by "encoding insertion code information based on the modulated digital watermark." Accordingly, Applicant believes that claims 1, 7, 13, 24, 47, 50, 57, 58 and 60 are patentable over Rhoads, Shur, Girod, and Kubota - taken either alone or in combination - on at least this basis.

Further, since dependent claims inherit the limitations of their respective base claims, Applicant believes that dependent claims 2-6, 8-12, 14-23, 25-34, 48, 49, 51, and 52 are patentable over Rhoads, Shur, Girod, and Kubota for at least the same reasons as discussed in connection with claims 1, 7, 13, 24, 47, 50, 57, 58 and 60.

Applicant respectfully submits that all of the claims now pending in the application are in condition for allowance, which action is earnestly solicited.

If any issues remain, or if the Examiner has any further suggestions, he/she is invited to telephone the undersigned at (908) 654-5000.

The Examiner is hereby authorized to charge any insufficient fees or credit any overpayment associated with the above-identified application to Deposit Account No. 12-1095.

The Examiner's consideration of this matter is gratefully acknowledged.

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Respectfully submitted,

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